

REMARKS

The Official Action mailed August 2, 2011, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes with appreciation the consideration of the Information Disclosure Statements filed on December 5, 2005; April 27, 2006; May 13, 2008; and September 30, 2008.

Claims 42-53 are pending in the present application, of which claims 42, 50 and 52 are independent. Claim 44 has been amended to better recite the features of the present invention. The Applicant notes with appreciation the indication of the allowability of claims 42-49, and the allowance of claims 50-53. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

Paragraph 1 of the Official Action objects to claims 44, 45, 48 and 49, asserting that the limitation of "the reaction means" in claim 44 should be "the creation means." In response and as required by the Official Action, claim 44 has been amended to recite "the reaction creation means." It is respectfully submitted that the recitation of "the creation means" reflects proper antecedent basis already established in independent claim 42. Reconsideration and withdrawal of the objection are in order and respectfully requested.

Paragraph 3 of the Official Action rejects 42-49 under 35 U.S.C. § 101, asserting that the claimed invention is directed to non-statutory subject matter. Specifically, the Official Action appears to rely on In Re Bilski, 88 USPQ2d 1385, to assert that "a statutory 'process' under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing" (pages 2 and 3, Paper No. 20110729). The Applicant respectfully disagrees and traverses the assertions of the Official Action.

Specifically, the Applicant notes that the rigid requirement of the Official Action that a valid process under § 101 "must" either be tied to a machine or transform an article directly violates both Supreme Court precedent, which directly superseded the Federal Circuit's Bilski decision, and also breaches Office policy.

Specifically, the Applicant respectfully notes that in Bilski v. Kappos, 561 U.S. \_\_\_\_; 130 S. Ct. 3218 (2010), the Supreme Court recently eviscerated the machine-or-transformation test, holding that § 101 does not strictly require a process claim to satisfy the machine-or-transformation test and instead only excludes "laws of nature, physical phenomena, and abstract ideas." The Court further stated that "adopting the machine-or-transformation test as the sole test for what constitutes a 'process' ... violates these statutory interpretation principles" and that "[the] Court is unaware of any 'ordinary, contemporary, common meaning' ... of the definitional terms 'process, art or method' that would require these terms to be tied to a machine or transform an article." Id. In other words, as the Federal Circuit recently lamented in Clasen Immuno v. Biogen Idec, slip opinion 2006-1634, (decided August 31, 2011; see "additional remarks" by Judge Rader):

"In the last several years, this court has confronted a rising number of challenges under 35 U.S.C. § 101. The language of § 101 is very broad. Nevertheless, litigants continue to urge this court to impose limitations not present in the statute... This court should decline to accept invitations to restrict subject matter eligibility."

Thus, the precedents are absolutely clear that statutory eligibility under § 101 is "very broad" and cannot be rigidly limited to claims that satisfy the machine-or-transformation test. Furthermore, contrary to the allegations of the Official Action, the Patent and Trademark Office has not "recently introduced a policy of rejecting claims directed to a device, system, or apparatus, for non-statutory subject matter when the underlying claims are actually method claims that fail to meet the requirements of the 'machine or transformation test'" (page 3, Paper No. 20110729). Instead, in a recent Memorandum dated June 28, 2010 to Patent Examining Corps on the subject of "Supreme Court Decision in Bilski v. Kappos," Robert W. Bahr, Acting Associate Chair

for Patent Examination Policy, noted that the machine-or-transformation test “is only a threshold inquiry” applicable to “a business method” and is “not the sole test for patent-eligibility of processes under 35 U.S.C. § 101.” Thus, the rigid requirement of the Official Action that a valid process under § 101 “must” either be tied to a machine or transform an article **directly violates** both the Court’s decision in *Bilski* and Acting Associate Chair Bahr’s interim guidance regarding the same. **Accordingly, the rejection under 35 U.S.C. § 101 is predicated on a complete disregard for Supreme Court precedent and Office policy, and, as such, is wholly improper on its face.**

Regardless, the claims of the present invention tie the claimed processes to a particular apparatus – the speech synthesis device to which the claims are directed. Therefore, even under this mere “threshold inquiry,” according to the Supreme Court and the Patent Office, the claims are directed to a machine rather than a business method or abstract idea and, as such, are per se eligible for statutory protection under 35 U.S.C. 101. As the Official Action appears to recognize, the claims further recite components of this machine, such as “means for predicting cadence” (page 3, *Id.*). The Official Action alleges that “e.g., ‘cadence prediction means … to predict the cadence’ … do not represent physical structures apart from a general purpose computer processor.” The Applicant respectfully disagrees. The claims each recite “means” for performing the various “functions” of the speech synthesis device, as the Official Action appears to recognize at the last line of page 3. Thus, it should be readily apparent that the claims recite “means plus function” language that is **expressly permitted under 35 U.S.C. § 112, paragraph 6**. Therefore, the apparent basis for the rejection appears to be **contrary** to the well established practice in U.S. patent law of means-plus-function claiming and, as such, the rejection is improper for this additional reason.

In any event, and as noted above, the machine-or-transformation test is “not the sole test for patent-eligibility of processes under 35 U.S.C. § 101.” See, for example, *Bilski*, *supra*, and the above-referenced Memorandum to Patent Examining Corps on

the subject of "Supreme Court Decision in Bilski v. Kappos." Accordingly, the assertion of the Official Action that the recitation of a speech synthesis device comprising various means does not tie the method to a particular apparatus, aside from being plainly wrong, does not sustain the Examiner's burden of proving that the claimed subject matter is non-statutory. Therefore, for the above-mentioned reasons, reconsideration and withdrawal of the rejection under 35 U.S.C. § 101 are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

The Commissioner is hereby authorized to charge fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(a), 1.20(b), 1.20(c), and 1.20(d) (except the Issue Fee) which may be required now or hereafter, or credit any overpayment to Deposit Account No. 50-2280.

Respectfully submitted,

  
Eric J. Robinson  
Reg. No. 38,285

Robinson Intellectual Property Law Office, P.C.  
3975 Fair Ridge Drive  
Suite 20 North  
Fairfax, Virginia 22033  
(571) 434-6789